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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* PAUL BILIBIN and JINYUE LIU

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Appeal 2008-005469
Application 09/684,861
Technology Center 3600

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Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

I. Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(3)(2007) of our Decision of November 30, 2009. The Decision affirmed the Examiner's rejection of claims 1-13, 15-17, and 19-23[2] under 35 U.S.C. § 103(a) as being unpatentable over Thiel in view of FedEx.

I. Appellants traverse the Board's Affirmance of the rejection of claims 1-13, 15-17, and 19-23 under 35 U.S.C. § 103(a) as being unpatentable over Thiel in view of FedEx based on the following points:

1A. The FedEx Reference Fails to Disclose, Either Explicitly or Inherently, Ever Determining a Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel, and Moreover, Fails to Disclose Determining the Claimed Limitations for a Cross-Comparison Delivery Schedule that Includes Delivery Dates and Times for Each FedEx Service.

1B. The Thiel Table Reproduced in Finding of Fact Number 7 is Not Determined or Generated by the Thiel System In Response to a User Request as Required by Claim 1, and Does Not, Therefore, Disclose the Claimed Limitations for Determining a Cross-Comparison Schedule.

2A. The Thiel Reference Fails to Disclose, Either Explicitly or Inherently, a Cross-Comparison Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel.

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[2] Although claims 22 and 23 are not listed by the Examiner in the heading of the 35 U.S.C. § 103(a) rejection of the December 20, 2005 Final Office Action, it is clear from the remainder of that Action that claims 22 and 23 were meant to be included because they are listed on the cover sheet as pending, rejected and addressed on the merits by the Examiner on pages 10-11 of the Final Office Action and in the Answer on page 12.

2B. As Compared to the Limitations of the Claims Which Provide For Determination of a Cross-Comparison Delivery Schedule That Comprises a Delivery Data and Time for Each Delivery Service Offered by Each Carrier in Response to a User Shipping Request.

2C. The FedEx Reference Fails to Disclose, Either Explicitly or Inherently Ever Determining a Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel.

3. The Thiel Reference Fails to Disclose, Either Explicitly or Inherently, a Cross-Comparison Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel, and Further Fails to Disclose Determining Elements For Each Delivery Service Offered by Each Carrier That Would Deliver a Parcel.

4. As Compared to the Appeal Decision Statements That the Appeal Brief Argument lc Relied on the Arguments Under Appeal Brief Argument lb, Appeal Brief Argument lc Advanced Additional Reasons Why Claims 3, 6, 9 and 16 Are Patentable.

## ANALYSIS ON REHEARING

Appellants' Item 1A.

i. Appellants argue:

> …that the FedEx reference amounts to nothing more than a general description of various services offered by FedEx® that explains general time frames and general delivery-timing rules that FedEx® applies to shipments, as compared to the claimed limitations of determining a potential cross-comparison delivery schedule comprising dates and times in response to a respective request by a respective particular user to ship a particular respective parcel. (Request 6).

We again disagree with Appellants and point to our Decision on page 11 where we also state that the FedEx® rules are properly founded in fact by the Examiner to be scheduling rules (FF 5) because they identify a respective delivery date and time for a package submitted to FedEx® for delivery, e.g., next-business-day delivery by 3 p.m. (FF 11). That is, while these rules may describe the services offered by FedEx®, they nevertheless must also accurately reflect real time delivery schedules implemented by FedEx®, otherwise the company would be put out of business for failing to honor its advertised promised delivery times. (Decision 11, 12)

ii. Appellants next argue:

> It is respectfully acknowledged that, as pointed out by the Board, FedEx® would apply its rules to deliver a particular parcel. However, it is respectfully suggested that FedEx® could have done so, at the time of the claimed invention, in a number of ways that would not have involved FedEx® ever determining a delivery date and a delivery time for delivery of the particular parcel to a particular destination. (Request 6)

Appellants' arguments are not persuasive because they are not based on limitations appearing in the claims and are not commensurate with the broader scope of the claims which merely require a cross-comparison delivery schedule comprising a respective delivery date and a respective delivery time for each respective particular delivery service. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Moreover, contrary to Appellants' argument here, the issue is one of claim interpretation, and not one of what

the prior art could have done. (Decision 13). Since we interpret delivery date and a delivery time for delivery to be met by that promised by the FedEx® delivery date and time schedule (FF 11), e.g., next-business-day delivery by 3 pm, the claim limitations are met.

Appellants' Item 1B.

i. Appellants argue that the "claimed cross-comparison delivery schedule comprise delivery dates and times for each delivery service offered by each carrier, not, as done in Thiel for fees, only for a pre-selected delivery service." (Request 8).

However, the Appellants' arguments again fail because they are not based on limitations appearing in independent claim 1 which does not require the simultaneous presentation of each delivery service offered by each carrier as argued by Appellants.

ii. Appellants also argue that "the table disclosed in Thiel is not determined or generated by the Thiel system in response to a user request…." (Request 8). We disagree with Appellants because our Decision at page 14 found that the user generates a request by defining the required services by entering the data with regard to the ship-to zone (the destination zone) and desired additional services, such as express delivery (FF 8), - which we interpret as a request.

Appellants' Item 2A.

i. Appellants next allege:

> Even though the Board seems to agree that Thiel does not disclose a cross-comparison delivery

> schedule (see Appeal Decision, p. 11, ¶2 ("... the Examiner acknowledges that Thiel does not disclose the schedule feature (FF 4) ...")), the Decision also sets forth a seemingly inconsistent position. See, e.g., Appeal Decision, p. 13, ¶¶2-3 ("The Examiner however found that Thiel discloses a cross comparison delivery schedule in the Table listed supra (FF 7) ... We agree with the Examiner."); see also, e.g., Appeal Decision, p. 9, FF 12 ("The Examiner found that Thiel discloses a cross comparison delivery schedule in the Table listed supra (FF 7) ..." (emphasis added)). (Request 9, 10)

We take exception to the Appellants' assertion of inconsistency in our Decision because a closer reading of our finding (FF 4) reveals that the Examiner found Thiel's delivery schedule deficient only to the extent that "Thiel does not expressly disclose that *the delivery schedule comprises a respective delivery date and a respective delivery time for each respective particular delivery*." (FF 4)

Consistent with this, the Decision limits its acknowledgement of a delivery schedule in Thiel only to a comparison table which "…lists different carriers and compares items associated with the carriers, such as express delivery and prices" (FF 12).

ii. Appellants assert that "the Thiel Table contains various settings that are used by the Thiel system for calculating shipping fees, but are not, themselves, calculated shipping fees." (Request 11).

Again, Appellants' assertion is not based on limitations appearing in the claims because claim 1 does not recite "calculating", but only requires that the schedule is "determined".

iii. Appellants then argue that "the dates that appear in Thiel's FIG. 2 are the effective dates ('Date for Updating') for a postal rate table that can be used by the Thiel system to calculate rates for a particular 'Country of Origin.'" (Request 12)

The argument however presupposes that we are relying on Theil for date and time information, which is not the case. Our Decision on page 14 makes it clear that Thiel is used to respond to the claim limitation of determining via "a request comprising a first address and a second address." Our corresponding finding on page 14 of the Decision was limited to data stored "as a supplementary function in such a way that it can be called up and ascertained in a further memory region A, B, C, etc., for *each country, and the appropriate zone….*" (FF 14). Our Decision and the Examiner's findings thus make it clear that we rely on the teachings of FedEx®, and not Thiel, for the required date and time features of the claims. (FF5), (Decision 11, 15).

Appellants' Item 2B.

i. Appellants restate their argument that Theil does not meet the claim limitation of: *in response to each respective request by each respective particular user of a plurality of users to ship a particular respective parcel*

because "Thiel discloses that before the cited Thiel Table is used the user of the franking machine first defines the required services." (Request 15)

However, as we stated in section 1B (ii) *supra*, we interpret the request by the user to correspond to the user entering the data with regard to the ship-to zone (the destination zone) and desired additional services, as the request.

Item 2C

i. Appellants assert that "the names of the various FedEx® delivery services, such as, for example, 'FedEx 2Day®', is not a determination of a duration of time in transit as found by the Board" because it does not define time in transit (Request 15).

Again, Appellants' argument fails because it is not based on limitations appearing in the claims which only require a "delivery time", and not a duration of time in transit.

ii. Appellants assert the Board's reliance on *Leapfrog Enterprises, Inc. v. Fisher Price, Inc.* is misplaced because "the cited combination of FedEx and Thiel fail to disclose all of the non-system elements of the claimed limitations of Claim 1." (Request 17).

We disagree with Appellants because the features which Appellants challenge in the delivery schedule of FedEx 2Day® could be updated using modern electronic components, such as found in Theil[3], in order to gain the

[3] Theil, discloses a franking device 1 including a control module 5 and memory means 3 connected to a weighing device 14 and display 4. (col. 7,

commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. *See Leapfrog Enterprises, Inc. v. Fisher Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Appellants' Item 3.

Appellants' arguments in this section have been address *supra* in item 1B(i) and in our Decision at pp. 16 and 17, and are not persuasive for the same reasons given therein.

Appellants' Item 4.

Appellants' arguments to the calculating feature in this section have been addressed *supra* in item 2A(ii), and are not persuasive for the same reasons given therein.

Regarding the simultaneous feature recited in claim 3, our finding (FF 7), *infra,* shows Thiel disclosing simultaneous cross-comparison of respective shipping rates (base charge), and the display of each respective shipping rate corresponding to a display of the respective service-specific (delivery to a given zone) carrier (Carrier 1, 2, 3…). The carrier-specific delivery schedule for the respective particular delivery service to ship the particular respective parcel limitation would be the result of combining Thiel and FedEx ® (FF 4, 5). Finding of fact 7 reads:

> Thiel discloses that:
>
> > The franking machine must store the services and the fees of the various carriers

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ll. 16-31).

in a comparable form. The following table is exemplary of such a comparison:

| | Carrier 1 | Carrier 2 | Carrier 3 | Carrier 4 | Carrier 5 |
|---|---|---|---|---|---|
| Destination Zone | A | B | A + B | A | A + B + C |
| Base Charge (B) | .32 | .50 | .70 | .75 | 1.05 |
| Express Delivery | -- | -- | + | + | + |
| Added Charge (E) | -- | -- | .40 | .30 | 0.00 |
| Return Receipt | | | | | |
| Added Charge (R) | -- | 2.10 | 1.90 | -- | 2.80 |
| Discount (D) | | | | | |
| >100 items | .06 | -- | -- | -- | .10 |
| >1000 items | .14 | .18 | .11 | -- | .18 |
| >10000 items | .25 | .25 | .25 | .40 | .30 |

(Thiel, col. 10, ll. 65-66; col. 11, ll. 1-14).

III. For the reasons above, we are not convinced that Appellants have shown with particularity points believed to have been misapprehended or overlooked by the Board in rendering its earlier Decision. *See* 37 C.F.R. § 41.52(a)(1) (2007). Accordingly, Appellants' request for rehearing is denied.

CONCLUSIONS OF LAW

We conclude that the decision to affirm the decision of the Examiner to reject claims 1-13, 15-17, and 19-23 on appeal under 35 U.S.C. § 103(a) over the prior art has not been shown to have been erroneous.

REHEARING DENIED

Appeal 2008-005469
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JRG

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